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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/928,451 | 08/14/2001 | Akihiko Okada | Q65793 | 8140 |

7590 09/19/2006

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EXAMINER

BROOKS, MATTHEW L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/928,451 | Applicant(s) OKADA, AKIHIKO | |
| | Examiner Matthew L. Brooks | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim 13 has been cancelled by Applicant and withdrawn from consideration in this action. And the Claims examined for purposes of this action are the ones submitted on 4/28/2005.

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the system components of the claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract **not exceed 150** words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-8 and 14** are rejected under 35 U.S.C. 102(b) as being anticipated by

PN: 6,009,078 (Kodimer).

5. With respect to **Claims 1, 2 and 14**: Kodimer discloses

A computer peripheral sales promoting system comprising:

a service status detecting means for detecting a service status of a computer peripheral (C1, 63-68);

a customer product information storing means for storing specification information of said computer peripheral and user information which specifies a user of

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said computer peripheral and also for consecutively updating and storing a service status detected by said service status detecting means are provided in a computer which serves as an upper-level system for said computer peripheral (C2, 1-6 and C3, 14-20 → in regards to the option of having an “upper level” computer; and C4, 40-46 and C5, 45-52 and C6 30-42 and C12, 4-10) ; and

a sales promoting terminal for making access to said customer product information storing means to thereby read out said specification information, said user information, and service status (C1, 45-53 and C12, 4-10 and C12, 55-65).

6. With respect to **claims 3 and 4**: Kodimer discloses

wherein said computer peripheral is arranged in a network (see Fig 1 and C1, 40-45 “network peripheral device).

7. With respect to **claims 5-8**: Kodimer discloses

wherein said computer peripheral comprises a data storing apparatus (See Fig 1, 11 wherein a printer comprises a data storing apparatus in that it has a memory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodimer in view of Microsoft Computer Dictionary in further view of Official Notice.

Kodimer discloses all of the limitations as laid out above. Further still Kodimer claims nearly the identical invention as Applicant in that it detects the condition of a network peripheral device and notifies a sales promoting terminal; thus allow a sales person to confirm through the sales terminal the service status of a computer peripheral without taking trouble of visiting customers. Moreover Kodimer teaches being able to detect "exceeding a threshold quantity of usage" (C12, 50-65 and claim 3).

In fact the only thing Kodimer fails to teach is that the network peripheral device is *only* a data storing apparatus. And the status/quantity of usage determination is that "of a spent disk capacity and load status of said data storing apparatus".

The Examiner however directs attention to the Microsoft Computer Dictionary definition of "peripheral" page 360 that establishes the equivalency of printer and disk drive/data storage device in the computing art as known peripherals. *As noted in the Dictionary both printer and storage devices are standard peripherals used in conjunction with a computer.* The substitution of a storage device for the printer of Kodimer would have been obvious to one of ordinary skill in the art at the time of the invention as it is irrelevant whether a the computer peripheral is a printer or storage device so long as the status of the peripheral is detected and sent to a "sales promoting terminal" as each

is a standard peripheral used by the ordinary artisan and both have been recognized in the art as such.

As to the actual "status" being detected and sent to the sales promoting terminal; the Examiner takes Official Notice that in the COMPUTER ART included within the bounds of checking the status of a storage device is that of checking the spent disk capacity and load status of said data storing apparatus as a convenient way for a user to determine available load capacity and future storage needs. It would have been obvious to one having ordinary skill in the art at the time of the invention to have checked for load status in the Kodimer reference if the peripheral was a storage apparatus as noted by Microsoft because the skilled artisan would have recognized that checking available/remaining disk space is key in checking the "status" of a storage device and that to automate this practice would save a consumer time of physically having to check disk storage and notify a sales terminal of the deficiency of load.

NOTE: Applicant's own submitted IDS substantiate Examiner's Official Notice that if one were checking status of a storage apparatus peripheral, that checking load is the way to go.

Response to Arguments

11. Applicant's arguments with respect to claims 1-12 and 14 have been considered but are moot in view of the new ground(s) of rejection.

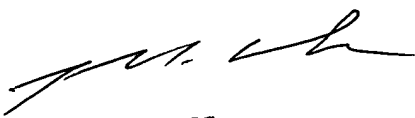
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
09/14/2006



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